

### **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application. Claims 1-12, 14-18 and 20 remain in the application, all of which stand rejected. Claims 13 and 19 have been canceled.

The specification has been amended, and two claims have been deleted, to remove indications of viscosity units that the Examiner has objected to as adding new matter. Applicants' deletion of these viscosity units is not an admission that they added new matter, but rather is an attempt to move this application forward to allowance.

**Claims 1-12, 14-18 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.**

Claims 1-12, 14-18 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Specifically, the Examiner states that, "[c]laims 1, 9, 12-15 and 18 cite the limitation of "thickfilm" dielectric, and that "thickfilm" is a relative term which renders the claims vague and indefinite, . . ."

Applicants previously asserted, and continue to assert, that the term "thickfilm" is a widely used and commonly understood industry term having a sufficiently clear and definite meaning. If the Examiner chooses to maintain his position that the term "thickfilm" is indefinite, then applicants ask the Examiner to please confer with his supervisor before forcing applicants to appeal to the Board from this position. Applicants respectfully believe the Examiner's position is wholly unsupportable.

In response to applicants' above position, the Examiner asserted that, "if thick films can be thinner than thin films, what is the point of having the term thick film." To a lay person, this argument may make logical sense. However, in the field in which

applicants work, the term thickfilm has a commonly understood meaning. The term thickfilm is clearly defined in both textbooks and dictionaries. Applicants' use of this well-defined term is therefore wholly reasonable and definite.

The Examiner further states that "[c]laims 9-10 and 18-19 contain the trademark/trade name KQ dielectric and KQ CL-90-7858." Specifically, the Examiner cites *Ex parte Simpson* and states that, "the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product."

Pursuant to M.P.E.P. § 608.01(v):

Names used in trade are permissible in patent applications if: (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or (B) In this country, their meanings are well-known and satisfactorily defined in the literature. See M.P.E.P. § 608.01(v) (8<sup>th</sup> Ed. Rev. 2003).

Applicants continue to assert that the limitations "KQ dielectric" and "KQ CL-90-7858" meet this requirement. As published on Heraeus Cermalloy's website, and in published papers, KQ dielectrics are glass dielectrics having a very low loss tangent (around  $10^{-4}$ ) and dielectric constant (around 3.9). Defining a dielectric as KQ CL-90-7858 is even more definite, as this is not merely a "trademark", but rather an identifier of a specific product having a specific composition. The specification for KQ CL-90-7858 is relied on in the industry, and is not subject to change.

In the case of *Ex parte Simpson*, 218 USPQ 1020 (1982), the court upheld the Examiner's claim rejections pursuant to 35 U.S.C. § 112, second paragraph, where the claims contained the indefinite trademark "Hypalon." In that case the court stated:

"The claim scope is uncertain as regards the material which forms the "Hypalon" membrane. On the one hand, the claim language may be very narrowly construed to a particular chlorosulphonated ethylene having a specific group of additives employed by the owner of the "Hypalon" trademark to produce the desired properties, or on the other hand the claim language might be

asserted by appellants, as it was in the unentered amendment filed July 27, 1978, to broadly encompass every *synthetic resin*."

The *Ex Parte Simpson* case was a rather unique case involving very vague claim language which was made even more confusing by 1) applicants' use of Hypalon as a noun, and 2) applicants' attempt to argue that Hypalon encompassed a broader range of materials than indicated by Hypalon's manufacturer. Conversely, applicants' claims 9-10 and 18-19 use the trade names "KQ dielectric" and "KQ CL-90-7858" in a proper manner, and it is clear what range of materials (or material) is encompassed by each of these terms.

The unique nature of the *Ex Parte Simpson* case is readily apparent after reviewing *Ex Parte Jerry Kitten*, WL 33134953 (1999, unpublished opinion), wherein the Board of Patent Appeals declined to follow its holding in *Ex Parte Simpson*, reversing the Examiner's rejections and finding that the use of trademarks did **not** render claims unclear or confusing. *Ex Parte Jerry Kitten* found:

[b]ased on these product sheets and because claim 13 further limits the fertilizer used in claim 1 to a fertilizer prepared from these well-identified proprietary products, we do not find the use of the trademarks renders claim 13 unclear or confusing. Compare, *Ex Parte Simpson*, 218 USPQ 1020-23 (Pat. & Tdmk. Off. Bd. App. 1982). *Ex Parte Jerry Kitten*, 1999 WL 33134953 (Bd. Pat. App. & Interf.)

Similarly, applicants' claims 9-10 and 18-19 further limit applicants' claims 1 and 17, respectively. Because applicants' claim 9-10 and 18-19 are even further limited by the well identified limitations of claims 1 and 17, respectively, claim 9-10 and 18-19 are even more definite and precise.

In response to applicants' above position, the Examiner asserts that the descriptions of KQ dielectric and KQ CL-90-7858 dielectric published on Heraeus Cermalloy's website are not definite because websites are subject to change. Although it is true that websites are subject to change, it is not true that relied-upon compositions of materials are subject to change. Applicants believe Heraeus

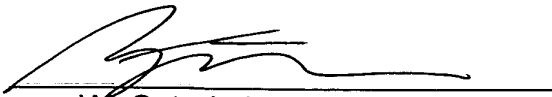
Cermalloy's published characteristics and/or compositions of these materials are relied upon by the industry and are not subject to change. Although Heraeus Cermalloy might introduce an additional KQ dielectric that fits under the KQ dielectric umbrella, applicants do not believe that Heraeus Cermalloy would change the general definition of KQ dielectric. Nor would Heraeus Cermalloy alter the composition of a dielectric that is specifically identified by part number (i.e., KQ CL-90-7858). The Examiner's contentions otherwise are mere speculation that applicants cannot address. Such speculation is believed inappropriate absent some positive belief on the Examiner's part that Heraeus Cermalloy would (or is likely to) take such actions.

#### **Allowable Subject Matter**

Although the Examiner has indicated that claims 1-12, 14-18 and 20 would be allowable if rewritten or amended to overcome the above rejections under 35 U.S.C. 112, second paragraph, it is believed that Applicants' Amendment and Remarks will persuade the Examiner to withdraw his rejections.

Given the above Amendment and Remarks, applicants respectfully request the timely issuance of a Notice of Allowance.

Respectfully submitted,  
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